

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

FEB. 4, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Doctor's Associates Inc.

Serial Nos. 75/098,154 and 75/098,625

Francis J. Duffin of Wiggin & Dana for Applicant.

Angela Bishop Wilson, Trademark Examining Attorney, Law
Office 101 (Jerry Price, Managing Attorney).

Before Sams, Quinn and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Doctor's Associates Inc. has filed an application for
registration of the mark "MIA VIA PIZZA and design" as
shown below for "restaurant services."¹

¹ Serial No. 75/098,154, in International Class 42, filed May 3, 1996, based upon an allegation of a *bona fide* intention to use the mark in commerce. In response to the initial Office action, applicant has disclaimed the word "PIZZA" and submitted an English translation of its marks as "My Street Pizza."



On the same day, applicant filed a companion application for a typed drawing of the mark "MIA VIA PIZZA," also for "restaurant services."²

The Trademark Examining Attorney issued a final refusal to register based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's proposed marks, when used in connection with restaurant services, so resemble the registered mark, "VIA MIA," when applied to pasta, as to be likely to cause confusion, or to cause mistake, or to deceive.³

Inasmuch as these applications involve common questions of law and fact, and each has been treated in substantially the same manner by the applicant and by the Trademark Examining Attorney, we have consolidated these two appeals by issuing a single decision.

² Serial No. 75/098,625, in International Class 42, filed May 3, 1996, based upon an allegation of a *bona fide* intention to use the mark in commerce.

³ Registration No. 1,893,706 issued on May 9, 1995. The registration sets forth dates of first use of June 2, 1993. The translation statement in the registration is as follows: " 'VIA' in Italian translates as 'street, road or way.' 'MIA' in Italian is the adjective for 'My.' "

Applicant argues that its marks create a different overall commercial impression from registrant's mark -- that the Trademark Examining Attorney has inappropriately dissected its marks to find confusing similarity with registrant's mark. Also, applicant takes the position that registrant has a weak mark, entitled to a narrow scope of protection. Finally, applicant argues that its restaurant services and registrant's goods (i.e., "pasta," presumably sold at retail in food stores, grocery markets, etc.) move in distinctly different channels of trade.

The Trademark Examining Attorney, in turn, contends that the dominant portion of applicant's marks ("MIA VIA") simply comprises a transposition of registrant's mark ("VIA MIA"), thus concluding there are strong similarities in the sound, meaning and overall appearance of the respective marks. Furthermore, the Trademark Examining Attorney argues that applicant's restaurant services are closely related to registrant's food products. The Examining Attorney asserts that registrant's pastas are the types of food items likely to be served in applicant's restaurant, and that food products and restaurant services are commonly marketed by a single entity under a single mark. In connection with the refusal to register, the Examining Attorney submitted third-party registrations showing that a

single entity has registered the same mark for restaurant services featuring pasta and pizza. Similarly, she has made of record registrations by a single entity using the same mark for restaurant services as well as food products. The Trademark Examining Attorney argues that the common origins of pasta and pizza in traditional Italian cuisine would heighten consumers' perceptions of a common source.

In the course of rendering this decision, we have followed the guidance of In re E.I. duPont deNemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973), which sets forth factors which, if relevant, must be considered in determining likelihood of confusion. However, in any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services.

Under Section 2(d) of the Act, we must compare applicant's two "MIA VIA PIZZA" marks to registrant's "VIA MIA" mark. The respective marks must be considered in their entirety. Nevertheless, in supporting a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on

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consideration of the marks in their entirety." In re National Data Corp., 753 F.3d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant's marks comprise mere transpositions of registrant's entire mark, with the addition of the generic word, "PIZZA." That "a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark..." In re National Data Corp., *supra* at 751.

Clearly, when applicant's marks are viewed in their entirety, the term "MIA VIA" is the dominating and distinguishing element thereof. See, e.g., In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir 1997) [dominant portion of the mark THE DELTA CAFE and design (CAFE disclaimed) for restaurant services is the word DELTA.] In the instant case, this is an ethnic sounding term suggesting Italian food. Finally, to the extent one familiar with the Italian language were to translate these respective marks into the English language, both carry the identical connotation of "My Street" in spite of the transposition of words.

In finding that the marks are similar, we have kept in mind the normal fallibility of human memory over time and the fact that the average consumer retains a general rather than a specific impression of trademarks encountered in the marketplace. This is especially the case given the largely impulse nature of these particular purchases.

In the service mark application (Ser. No. 75/098,154) having a special form drawing, although the word "PIZZA" is presented in all upper-case and larger letters than the words "MIA VIA," inasmuch as the word "Pizza" is generic, the words "MIA VIA" still comprise the strongest source-identifying matter found within this mark. Similarly, the design feature may be prominent, but it is suggestive of an Italian flag, thereby reinforcing the commonality of the marks. Hence, we find that these marks are similar as to sound, meaning and appearance.

Applicant argues that the cited mark is weak because of third-party registrations for food products and/or restaurant services having a "VIA" component, and therefore should be accorded a narrow scope of protection. Applicant bases this argument on a summary of third-party registrations contained in a table produced by a word processor and attached to applicant's response to an Office

action. This table was reproduced again as an exhibit attached to applicant's appeal brief. Following this second submission, the Trademark Examining Attorney objected in her appeal brief (p. 8) to applicant's submission, stating that the original submission of evidence of these registrations was not in the proper form. Applicant then provided soft copies of the third-party registrations with its reply brief.

While the Examining Attorney is technically correct in making her objection, it came too late. It is true that in order to make third-party registrations of record, soft copies of the registrations or photocopies of the appropriate U.S. Patent and Trademark Office electronic printouts should be submitted prior to the time of the appeal.⁴ Hence, the copies of registrations submitted at the time of its reply brief in support of applicant's "weak mark" argument would normally be rejected as untimely. On the other hand, in her final refusal, the Trademark Examining Attorney treated these registrations, although submitted in the form of a summary, as if of record. In this Office action, she commented on the substance of this evidence without objection. Accordingly, while applicant did not comply with the established rule that the

evidentiary record in an application must be complete prior to the filing of the notice of appeal,⁵ the Trademark Examining Attorney waived her right to object thereto at the time of her final Office Action.

Nonetheless, the evidence of subsisting registrations is entitled to little weight since it is well settled that such registrations are incompetent to prove that these marks are in use or that the public is exposed to them.

See Fort Howard Paper Co. v. Kimberly-Clark Corp., 221 USPQ 732 (TTAB 1984) and In re Hub Distributing Inc., 218 USPQ 284 (TTAB 1983).

A closer look at the third-party registrations proffered by applicant does not alter our decision herein. We remain unpersuaded by applicant's attempt to portray "VIA" and "MIA" formatives, individually, as being weak in the food or restaurant fields. Certainly, not one of the third-party marks pointed to by applicant (e.g., "ZIA MIA," "PIZZA VIA," "PIZZA MIA," "VIA PASTA") is as similar in sound, meaning or appearance to registrant's "VIA MIA" as is applicant's "MIA VIA PIZZA."

⁴ See Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992).

⁵ See, 37 CFR 2.142(d); In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994).

Given the strong similarity of the marks, the question of likelihood of confusion turns principally on the relationship between the goods and services herein. It is well settled that they need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods and services are related in some manner. The circumstances surrounding their marketing need only be such that they would be likely to be encountered by the same persons under situations that would give rise to the mistaken belief that they are in some way associated with the same producer or provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978); and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

We acknowledge that there is no *per se* rule which mandates a finding that confusion is likely whenever eateries and various food items are marketed under identical or similar marks. To establish likelihood of confusion, more must be shown than that similar marks are used for various food products and/or for restaurant services. See, e.g., Jacobs v. International Multifoods Corporation, 668 F.2d 1234, 212 USPQ 641 (CCPA 1982); and In re Central Soya Company, Inc., 220 USPQ 914 (TTAB 1984).

In the case now before us, we have applied no *per se* rule but have decided this case on its own facts, examining the parties' particular marks and particular goods and services. This is consistent with the reported decisions where the factual differences between cases having opposite results are often subtle ones.

When employing the duPont factors to focus on all the known circumstances surrounding use of these marks in the relevant marketplace, we note what our reviewing court said on this very subject:

While we recognize that the average consumer makes a distinction between fast-food restaurants and supermarkets, we are satisfied that, if the marks themselves are confusingly similar, customers of the fast-food restaurant would be likely to believe that opposer owned, sponsored, or supplied that business.

Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 394 (Fed. Cir. 1983). The Trademark Examining Attorney has placed convincing evidence into the record from the LEXIS/NEXIS database showing that during the intervening years, national food service companies have taken their house marks - service marks once used strictly for restaurant services -- and increasingly expanded the same marks into successful trademarks for related food

products. In some cases these packaged food items, undoubtedly, are sold at retail right at the restaurant, while other times they may well be found in one's local supermarket. The Examining Attorney has introduced use-based third-party registrations demonstrating this trend. Although these registrations are not evidence that the different marks shown therein are in use or that the public is familiar with them, they nevertheless have probative value to the extent that they serve to suggest that the goods and services listed therein (which are the same types of goods and services involved herein) are of a kind which may emanate from a single source. Accord In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993); and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467 (TTAB 1988).

Finally, registrant's goods are listed on the registration simply as "pasta" -- without restriction as to the channels of trade. Presumably these goods are equally as likely to appear in delicatessens, restaurants, food markets, as in any other retail establishment where food items are sold.

The record here satisfies the "something more" evidentiary language articulated by our reviewing court in

Jacobs v. International Multifoods Corp., *supra* at 642. In finding that applicant's restaurant services are closely related to registrant's food products, we should point out that we are not considering just any two food items, but both are traditional Italian foods quite popular throughout the United States. Stated differently, the average consumer would view Italian food items and Italian restaurant services as emanating from or sponsored by the same source if such goods and services are sold under the same or substantially similar marks. See In re Golden Griddle Pancake House Ltd., 17 USPQ2d 1074 (TTAB 1990) [GOLDEN GRIDDLE PANCAKE HOUSE (PANCAKE HOUSE disclaimed) for restaurant services and GOLDEN GRIDDLE for table syrup is likely to cause confusion; undeniable connection between pancake syrup and a restaurant that serves pancakes and syrup, especially since "restaurants frequently package certain of their products for retail sale"]; and Roush Bakery Products Co., Inc. v. Ridlen et al., 190 USPQ 445 (TTAB 1976) [customers of opposer's HILLBILLY bread and rolls are likely to believe that applicant's restaurant, using substantially the same mark, is approved, sponsored by, or affiliated with opposer; the likelihood of confusion is exacerbated by applicant's sales of bread --opposer's specific product].

Accordingly, we find that the subject marks are similar as to sound, meaning and appearance, and the services and goods are closely related, resulting in a likelihood of confusion.

Decision: The refusals to register in both application files are hereby affirmed.

J. D. Sams

T. J. Quinn

D. E. Bucher

Administrative Trademark
Judges, Trademark Trial and
Appeal Board